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## Fax Cover Sheet

DATE: November 6, 2001

FROM: Brian Rosenbloom

Direct Dial 703-464-4810

To:

NAME	COMPANY	BUSINESS #	FAX #
Examiner M. Norman	USPTO		703-746-5551

7238

MESSAGE:

RE: U.S. Patent Application No: 09/100,133, filed on June 19, 1998

Dear Examiner Norman,

Enclosed please find an Amendment that we filed on Oct. 1, 2001 and a true copy of a date stamped postcard that indicates that the Amendment was received in the Patent Office on Oct. 1, 2001.

Very Truly Yours,  
Brian Rosenbloom  
Reg. No. 41,276

**We are sending a total of 8 pages, including this cover sheet.**

Please call us at 703.464.4800, if you experience any problems.

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<input checked="" type="checkbox"/> Data Entry	<i>[Signature]</i>
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<input type="checkbox"/> ELITE	
<input type="checkbox"/> Amended	

Atty Docket No.: 23452-012

Inventor(s): CONMY *et al.*

Serial No.: 09/100,133

Filing Date: June 19, 1998

Title: **ELECTRONIC CALENDAR WITH GROUP SCHEDULING AND  
STORAGE OF USER AND RESOURCE PROFILES**

Documents Filed: 1. Reply to Final Office Action Under 37 C.F.R. § 1.116

VIA HAND DELIVERY

Sender's Initials: BSR/mrs

Date: October 1, 2001

Atty Docket No.: 23452-012

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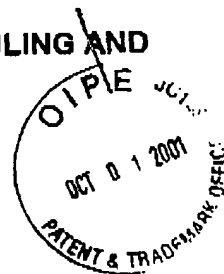
Title: **ELECTRONIC CALENDAR WITH GROUP SCHEDULING AND  
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VIA HAND DELIVERY

Sender's Initials: BSR/mrs

Date: October 1, 2001



PATENT

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Douglas Walter CONMY *et al.*

Appl. No.: 09/100,133

Filed: June 19, 1998

Art Unit: 2163

Examiner: Marc E. NORMAN

Atty Docket: 23452-012  
(Formerly 52817.000013)For: **Electronic Calendar with Group  
Scheduling and Storage of User and  
Resource Profiles**#17/11  
11-8-01  
B. Hilliard**BOX AF**The Assistant Commissioner for Patents  
Washington, D.C. 20231**Reply to Final Office Action Under 37 CFR §1.116**

Dear Sir:

This communication is in response to the Final Office Action mailed July 10, 2001.

Serial No.: 09/100,133

**REMARKS**

Reconsideration of this Application is respectfully requested.

With the foregoing amendment, claims 1-16 are pending in the application, with claims 1, 5, 6 and 7 being in independent form.

Based on the following remarks, Applicants respectfully requests that the Office reconsider all outstanding objections and rejections, and that they be withdrawn.

***Rejections Under 35 U.S.C. § 103***

The Office has rejected claims 1-16 under 35 U.S.C. 103(a) as being unpatentable over *Hotaling* (US 5,124,912), in view of *Buhrmann* (US 5,903,845). Applicants respectfully traverse these rejections and submit that the rejected claims are allowable over the art of record.

The Office has the burden of establishing a prima facie case of obviousness. *M.P.E.P.* §2142. In this case, the Office has not met this burden. In order to establish a prima facie case of obviousness, the references when combined must teach all of the claimed features or there must be some suggestion or motivation to modify one or both of the references such that when the modified references are combined they teach all of the claimed features. *M.P.E.P.* §2143.

With respect to claim 1, Applicants respectfully submit that *Buhrmann* and *Hotaling*, considered alone or in combination, do not teach or suggest all of the elements of claim 1. For example, at the least, neither *Buhrmann* nor *Hotaling* teach or suggest "automatically updating the invitee's profile based on the invitee's response to the invitation." Consequently, in order for claim 1 to be obvious in view of *Buhrmann* and *Hotaling*, there must, at the least, be some suggestion or motivation to modify either *Buhrmann* or *Hotaling* so that they include a means for "automatically updating the invitee's profile based on the invitee's response to the invitation."

However, the Office has not asserted that there is any suggestion or motivation to modify either *Buhrmann* or *Hotaling* so that they include a means for "automatically updating the invitee's profile based on the invitee's response to the invitation." The Office has merely

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stated in a conclusory fashion that "automatically updating the invitee's profile based on the invitee's response to the invitation" is not patentably distinct from the prior art because "merely providing an automatic means to replace a manual activity which achieves the same result is not sufficient to distinguish over the prior art." *Final Office Action*, pages 2-3 (relying on *In Re Venner*).

Consequently, because the Office has not identified any particular motivation or suggestion to modify one or more of the references such that when the modified references are combined they teach or suggest all of the elements of claim 1, the Office has not established a prima facie case of obviousness.

Moreover, the fact that a means for "automatically updating the invitee's profile based on the invitee's response to the invitation" may or may not be patentably distinct from the prior art is not dispositive of the issue of whether claim 1 as a whole is patentable over the prior art. This is so because the Applicants are not claiming solely a means for "automatically updating the invitee's profile based on the invitee's response to the invitation." Rather, the Applicants are claiming a system comprising a number of elements, one of which happens to be a means for "automatically updating the invitee's profile based on the invitee's response to the invitation." It is well settled that "when determining obviousness, the claimed invention should be considered *as a whole*; there is no legally recognizable heart of the invention." *Para-Ordnance Mfg. v. SGS Importers Int'l, Inc.*, 73 F.3d 1085, 1087 (Fed. Cir. 1995); and *See M.P.E.P.* § 2141.02. In this case, the Office is clearly not considering the claimed invention as a whole.

By focusing on the one element of claim 1 discussed above and not on claim 1 as whole, the Office has wrongly characterized the invention as "merely providing an automatic means to replace a manual activity which accomplishes the same result," and has thus wrongly relied on *In re Venner* in rejecting the claims. Applicants respectfully submit that the invention of claim 1 does more than merely provide an automatic means to replace a manual activity. The invention, in fact, provides a specific system for scheduling time intervals for a plurality of invitees.

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More specifically, the system as claimed in claim 1 comprises a number of elements, including: a database, a request generating means, a busy time determination means, a means for scheduling, and a means for automatically updating the invitee's profile. Therefore, because a system according to claim 1 does more than merely provide an automatic means to replace a manual activity, the Office's reliance on *In re Venner* is misplaced. Moreover, *In re Venner* does not stand for the proposition that converting any manual operation to an automatic operation is routine in the art. See *Ex Parte Carlsen*, 2000 WL 33256844 (Bd.Pat.App. & Interf. 2000) ("We do not agree with the Office that *In re Venner* makes converting any manual operation to an automatic operation routine in the art.").

Lastly, even if *In re Venner* did apply (it does not), Applicants respectfully submit that claim 1 is not obvious in view of *In re Venner* because the result achieved by the present invention is not the same as the result achieved by the prior art systems. For example, in the prior art systems, a person's electronic calendar is *not always* updated each time the person accepts an invitation generated by the system because, for example, the person may not have access to his electronic calendar when he accepts the invitation or he may forget to update his calendar. In contrast, in a system according to claim 1, the electronic calendar of a person who uses the system is *always* updated each time the person accepts an invitation generated by the system. At least this difference between the result achieved by prior art systems and the result achieved by a system according to claim 1 is substantial. In a system according to claim 1, a person accepting an invitation never has to worry about updating his electronic calendar. The same can not be said for a person who uses a prior art system.

As stated above, the Office has the burden of establishing a prima facie case of obviousness. In this case, the Office has not met this burden. To meet the burden the Office must show that there is some suggestion or motivation to modify either *Buhrmann* or *Hotaling* such that as modified they include all of the elements of claim 1. The Office has not made this showing. The Office simply states, "merely providing an automatic means to replace a manual activity ... is not sufficient to distinguish over the prior art." *Final Office Action*, pages 2-3. In short, nowhere has the Office identified a suggestion or motivation to

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modify either *Buhrmann* or *Hotaling* such that as modified they include all of the elements of claim 1.

Applicant, therefore, respectfully requests that the rejection of claim 1 be withdrawn.

With respect to dependent claims 2-4, the above remarks for claim 1 apply, because claims 2-4 depend from claim 1. With respect to independent claims 5-7, the above remarks for claim 1 apply because, like claim 1, claims 5-7 include the feature of "automatically updating the invitee's invitee profile based on the invitee's response to the invitation." With respect to dependent claims 8-16, the above remarks apply because these claims depend from one of claims 1, 5, 6 and 7.

#### Conclusion

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Office reconsider all presently outstanding objections and rejections, and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance.

If the Office believes, for any reason, that personal communication will expedite prosecution of this application, the Office is invited to telephone the undersigned at the number provided.

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Favorable consideration of this application is respectfully requested.

Respectfully submitted,

MINTZ, LEVIN, COHN, FERRIS, GLOVSKY, AND POPEO PC



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